

REMARKS

Reconsideration of this application, as amended, is respectfully requested.

Initially, the Applicants would like to thank the Examiner for the continued indication that claims 7, 9, 13, 15, 20, 22 and 26 are allowed.

As another initial matter, the Examiner has indicated some of the previously submitted references as being considered on a form PTO-1449 attached to the Office Action of October 13, 2005. However, the Examiner has crossed out reference JP 7-227398 as not being considered. The IDS of January 5, 2004 states that the relevancy of such reference is described in the specification. Thus, no translation is required since such discussion in the specification serves as a concise explanation of the reference's relevancy in the English language (which could be separate or part of the specification) (see 37 CFR 1.98(a)(3)(i)). Thus, Applicants respectfully submit that the IDS of January 5, 2004 fully complies with the requirements of 37 CFR 1.98 and request that the Examiner re-issue the form PTO-1449 with an indication that reference JP 7-227398 has been considered.

In the Official Action, the Examiner again rejects claims 1-6, 8, 10-12, 14, 16-19, 21, 23-25 and 27-35 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2001/0027313 to Shimmura et al., (hereinafter "Shimmura") in view of U.S. Patent No. 5,957,423 to Kronner (hereinafter "Kronner").

In response, Applicants respectfully traverse the Examiner's rejection under 35 U.S.C. § 103(a) for at least the reasons set forth below. However, independent claims 1, 27 and 30 have been amended to clarify their distinguishing features. Specifically, claim 1 has been amended to recite that "the supporting mechanism being a rigid member with no rotating joints." Independent claims 27 and 30 have been similarly amended.

The amendment to claims 1, 27 and 30 is fully supported in the original disclosure. Thus, no new matter has been introduced into the disclosure by way of the present amendment to independent claims 1, 27 and 30.

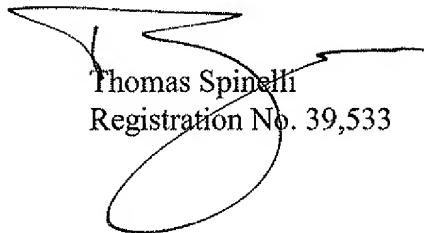
According to the Official Action, the Examiner argues that extracting a leading portion from the distal arm section 33 of Kronner and inserting it in place of the rigid scope 12 of Shimmura results in an arrangement equivalent to the invention as recited in independent claims 1, 27 and 30. However, Applicants respectfully submit that the grip 34 of Kronner includes the second pivot assembly 38, which differs from the supporting mechanism of the claimed invention, which is formed as an integral unit having no rotating joints. As discussed above, independent claims 1, 27 and 30 have been amended to emphasize such features. Furthermore, such a structure results in advantages over the fictitious combination of Shimmura and Kronner. Namely, with such a structure, the medical instrument holding apparatus as recited in independent claims 1, 27 and 30 allows downsizing of the supporting mechanism.

With regard to the rejection of claims 1-6, 8, 10-12, 14, 16-19, 21, 23-25 and 27-35 under 35 U.S.C. § 103(a), independent claims 1, 27 and 30 are not rendered obvious by the cited references because neither the Shimmura patent application nor the Kronner patent, whether taken alone or in combination, teach or suggest a medical instrument holding apparatus having the features discussed above and recited in independent claims 1, 27 and 30. Accordingly, claims 1, 27 and 30 patentably distinguish over the prior art and are allowable. Claims 2-6, 10-12, 14, 16-19, 21, 23-25, 28, 29, 31, 32 and 35 being dependent upon claims 1, 27 and 30, are thus at least allowable therewith. Consequently, the Examiner is respectfully

requested to withdraw the rejection of claims 1-6, 8, 10-12, 14, 16-19, 21, 23-25 and 27-35 under 35 U.S.C. § 103(a).

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicant's attorney would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,



Thomas Spinelli
Registration No. 39,533

Scully, Scott, Murphy & Presser, P.C.
400 Garden City Plaza, Ste. 300
Garden City, New York 11530
(516) 742-4343
TS:cm